

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Valerie Kucharewski et al.	Art Unit : 2145
Serial No. : 10/715,215	Examiner : Ajay M. Bhatia
Filed : November 18, 2003	Conf. No. : 2245
Title : PEOPLE LISTS	

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, appellants respond to the Examiner's Answer as follows:

A. With one notable exception, which is addressed more fully below in Section C of this Reply Brief, Section (9) "Grounds of Rejection" of the Examiner's Answer appears to largely restate arguments previously presented by the Examiner in, for example, the final Office Action of August 20, 2007 and the Advisory Action of November 15, 2007. See Examiner's Answer at page 3, line 5 to page 12, line 5. Responses to those arguments were provided in Appellants' Appeal Brief of May 5, 2008.

B. At paragraph B of Section (10) "Response to Argument," the Examiner states:

the Examiner has interpreted [the terms "a set of contacts" and "as a group"] as broadly as possible in light of the specification and in terms of the art. Specifically a set in the art is a math [sic] mathematical term, which is understood to possible [sic] contain 0, 1 or a finite amount of objects (see definition of a set<sup>1</sup>). Therefore as appellant has admitted the prior [art] anticipates this feature by teaching an individual user who is passively recognized as a group of on [sic] and a set of one.

Examiner's Answer at page 13, lines 4-9. Without commenting on (and/or acquiescing to) the Examiner's definition of a set, appellants note that the Examiner's stated construction ascribes the same meaning to both the phrase "a set of contacts" and the phrase "as a group," thereby rendering the phrase "as a group" superfluous.

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<sup>1</sup> Appellants are unsure of to what definition this citation refers.

It is well settled that a claim is to be interpreted so as to give effect to all terms in the claim. Bicon, Inc. v. Straumann Co., 441 F.3d 945, 950 (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); see also Innova/Pure Water, Inc. v. Safari Water Filtration Sys., 381 F.3d 1111, 1119 (Fed. Cir. 2004) (“[A]ll claim terms are presumed to have meaning in a claim.”); and Merck & Co. v. Teva Pharmaceuticals USA, Inc., 395 F.3d 1364 (Fed. Cir. 2005), reh’g en banc denied, 405 F.3d 1338 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 488 (2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”). It also is well settled that terms in a claim are to be interpreted in light of, and in the context of, the other terms in the claim. Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc), cert. denied, 126 S. Ct. 1332 (2006) (“[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms. . . . To begin with, the context in which a term is used in [a] claim can be highly instructive.”).

Under these principles, the phrase “a set of contacts” should be construed in light of, and in the context of, the phrase “as a group.” Furthermore, the phrase “a set of contacts” should be construed in a manner that gives effect to the phrase “as a group.” The Examiner’s construction limiting the phrase “a set of contacts” to an individual user, therefore, is incorrect. When properly construed to give effect to the phrase “as a group,” the recited “set of contacts” includes multiple contacts. And, for the reasons discussed in appellants’ Appeal Brief of May 5, 2008, Bates fails to describe or suggest passively recognizing that a set of multiple contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of multiple contacts and that is useful in addressing future communications to the set of multiple contacts as a group based on passively recognizing that the set of multiple contacts are, as a group, repeatedly sent communications by the member.

C. As discussed in appellants’ Appeal Brief of May 5, 2008 and appellants’ Amendment in Reply to Action of August 20, 2007, the final Office Action failed to present a ground of rejection for dependent claim 5. See, e.g., Appeal Brief of May 5, 2008 at page 3, line 28 to page 4, line 22; and Amendment in Reply to Action of August 20, 2007 of October 22, 2007 at page 7, line 16 to page 8, line 9. Section (9) “Grounds of Rejection” of the Examiner’s Answer

now includes a ground of rejection of dependent claim 5. Because the final Office Action failed to present a ground of rejection for dependent claim 5, the inclusion in the Examiner's Answer of the ground of rejection for dependent claim 5 amounts to a new ground of rejection.

Nevertheless, despite the inclusion of the new ground of rejection for dependent claim 5 in the Examiner's Answer, appellant wishes to maintain the Appeal.

Dependent claim 5 depends indirectly from independent claim 1. Accordingly, appellants request reversal of the rejection of dependent claim 5 at least because of its dependency and for the reasons discussed in connection with independent claim 1 in appellants' Appeal Brief and this Reply Brief. Appellants also request reversal of the rejection of dependent claim 5 for the additional reasons discussed below.

Dependent claim 5 itself introduces language reciting that the method of claim 4 further comprises enabling the member to delay the generation of a rejected contacts list. The Examiner's Answer contends that Bates teaches this feature at column 10, line 60 to column 11, line 14. Appellants disagree.

The portion of Bates cited by the Examiner describes an intelligent search routine that searches a contacts database for user names of potential e-mail recipients as an e-mail sender enters a user name in the address field of an e-mail:

Routine 110 begins in block 120 clearing a search criteria defined for the local user. Next, in block 122, the system waits for additional input from a user, e.g., depression of a character or other key. Next, in block 124, it is determined whether the additional input indicates that the displayed name should be accepted, e.g., by a user depressing the "ENTER" key or depressing a toolbar button or other user interface control on a display. If the additional input is not a request to accept the displayed name, block 124 passes control to block 125 to update the search criteria based upon the additional user input. For example, if the user has depressed a character key, that character is appended to the search criteria. In the alternative, the user may perform other editing operations on the search criteria, e.g., by depressing the backspace key, highlighting a portion using a mouse pointer, etc., or by other mechanisms by which updates of the search criteria may be made. Next, block 126 builds a list of all entries that match the search criteria from the local contact database for the local user. It should be appreciated that searching a database based upon a search

criteria is well known in the art, and thus, need not be discussed in greater detail herein.

Bates at column 10, line 60 to column 11, line 14. There is no teaching within this passage of enabling a member to delay the generation of a rejected contacts list, as recited in dependent claim 5. Accordingly, appellants request reversal of the rejection of dependent claim 5 for at least this additional reason.

**D.** At Section (8) "Evidence Relied Upon," the Examiner's Answer lists Courant, R. and Robbins, H. "The Algebra of Sets." Supplement to Ch. 2 in What is Mathematics?: An Elementary Approach to Ideas and Methods, 2nd ed. Oxford, England: Oxford University Press, pp. 108-116, 1996 as evidence upon which the Examiner relied. In addition, the Examiner appended an article entitled "Set" to the Examiner's answer. This article appears to have been retrieved from the website: <http://mathworld.wolfram.com/Set.html> on June 16, 2008.

Appellants have been unable to ascertain for what purpose the Examiner relied on the cited Courant, R. reference. In addition, appellants have been unable to ascertain whether the Examiner relied upon the appended "Set" article and, if so, for what purpose. To the extent the Examiner was attempting to list the appended "Set" article in the "Evidence Relied Upon" section, appellants note that the citation to the Courant, R. reference listed in the "Evidence Relied Upon" section is not the appropriate citation for the appended "Set" article. Rather, the Courant, R. reference appears to be a reference that itself was cited by the appended "Set" article.

To the extent that the Examiner relied on either or both of the Courant, R. reference and the "Set" article, appellant requests clarification as to the purpose of such reliance.

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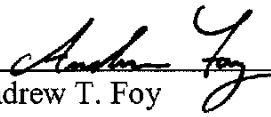
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For the reasons noted above as well as for the reasons stated in the Appeal Brief of May 5, 2008, appellants request that the final rejection be reversed.

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Respectfully submitted,

Date: August 25, 2008

  
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